

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-18 are presently active in this case, Claims 1-2, 13, and 16 having been amended by the present amendment.

Claims 1-18 stand rejected under 35 USC §103(a) as being unpatentable over Mori et al (6,242,825) in view of Ford (2,320,922).

The present amendment is made to advance prosecution and to that end amends the independent claims to clarify that --the second glue [is] provided in an amount sufficiently small so as not to inhibit impregnation of impregnating resin, yet sufficiently large so as to impede outflow of said inorganic particle--, consistent with the disclosure at page 12, line 25 – page 13, line 16 of the specification. No new matter has been added.

There is no teaching whatsoever in the prior art of efficacy of a second glue component insoluble in the impregnating resin, the second glue provided in an amount sufficiently small so as not to inhibit impregnation of impregnating resin, yet sufficiently large so as to impede outflow of said inorganic particle. Neither of the cited references teaches use of both first and second glue components, and neither teaches the functionality of the second glue component, which prevents inorganic particles 14 from flowing out of insulation layer 8 during subsequent heat treatment,<sup>1</sup> while nevertheless not inhibiting the impregnating resin from being impregnated,<sup>2</sup> as would certainly be a concern in the Mori et al system. Indeed, one skilled in the art would be disinclined to modify Mori et al glue system by adding a second glue component insoluble in the impregnating resin precisely because of

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<sup>1</sup> Specification, page 13, lines 7-16.

<sup>2</sup> Id., page 12, lines 22-27.

the possibility that impregnation would be inhibited. Furthermore, as required by the MPEP, "the prior art can be modified or combined to reject claims as prima facie obvious as long as there is a reasonable expectation of success, In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986),"<sup>3</sup> which is completely lacking in the cited prior art. In view of these deficiencies in the cited prior art, it is respectfully submitted that the amended independent claims clearly patentably define thereover.

Likewise, there is absolutely no teaching in the cited prior art that the second glue component contained in the adhesive is 0.5 wt% to 5 wt% with respect to the adhesive, as recited in Claims 4, 5, 8, 10 and 12. These claims are thus believed to be even further patentably distinguishing over the cited prior art.

Accordingly, reconsideration and withdrawal of the outstanding ground for rejection is believed to be in order and is respectfully requested.

Consequently, in view of the present amendment and in light of the above comments,

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<sup>3</sup> MPEP 2143.02, (emphasis added).

Application No. 10/690,644  
Reply to Office Action of October 12, 2006 and  
Notice of Appeal Filed: September 27, 2006

the present application is believed to be in condition for allowance. An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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